

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

NGB-32439

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed
name _____

Application Number

09/528,126

Filed

March 17, 2000

First Named Inventor

Noriyoshi Satoh et al

Art Unit

2618

Examiner

Richard Chan

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.


I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record. 57076
Registration number _____☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____


Signature

Brad C. Spencer

Typed or printed name

216-579-1700

Telephone number

July 1, 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.

☒ *Total of 2 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Noriyoshi Satoh *et al.*
Appln. No. : 09/528,126
Filed : March 17, 2000
Title : RADIO TERMINAL DEVICE
Conf. No. : 2947
TC/A.U. : 2618
Examiner : Richard Chan
Customer No. : 52054
Docket No. : NGB-32439

Mail Stop AF
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request review of the final rejections of claims 1-9 set forth in an Office action dated April 12, 2010 (Paper No. 20100326). No amendments are being filed with this request. A Notice of Appeal accompanies this request.

The pending claims were submitted in Amendment "N" dated December 29, 2009 and were finally rejected under 35 U.S.C. 103(a) as being unpatentable over Yokohama (EP 0522 538 A2) in view of Crowley (US 5,493,702). See the Office action at page 2.

Claim 1 requires a portable telephone including a portable telephone housing configured by a resin housing and a metal housing having a metal external surface forming an external surface of the telephone. The resin housing and metal housing are parts of the portable telephone.

Yokoyama is cited for teaching a portable telephone with a resin housing. The resin housing has a metal shielding case *located inside of the resin housing* (see Fig. 1). Yokoyama's telephone lacks an exterior metal housing.

Crowley's docking arrangement housing 16 is cited for teaching a metal housing. However, Crowley's docking arrangement housing 16 is not a part of a portable telephone, but a part of a docking arrangement for a portable telephone 12 (2:66-3:4). In Crowley, a portable telephone 12 having its own portable telephone housing is placed into the docking arrangement housing 16. Clearly, Crowley's docking arrangement housing 16 is not a part of a portable telephone.

Applicants submit that the cited combination of references merely teaches a portable telephone with a plastic housing, as taught by Yokoyama, and a separate, metal docking arrangement housing 16, as taught by Crowley. The cited references do not teach, or otherwise render foreseeable, a portable telephone including a portable telephone housing configured by a resin housing and a metal housing having a metal external surface forming an external surface of the portable telephone. Advantages provided by the claimed housing are rigidity and shock resistance without shielding an internal antenna.

Claim 1 further requires that the internal antenna be disposed on a rear surface of a printed circuit board and that the resin housing covers the rear surface of the printed circuit board, and that the metal housing forming an external surface of the telephone covers a front surface of the printed circuit board (the front and rear surfaces are two different surfaces of the printed circuit board). In the hypothetical combination of Yokoyama's telephone and Crowley's docking arrangement, Crowley's docking arrangement housing 16 and metal capacitive ground back plating 34 would cover the rear side of Yokoyama's plastic housing. As shown in Fig. 2, Crowley's housing 16 does not cover the front of a portable telephone. The front surface of Yokoyama's circuit board would be covered by Yokoyama's plastic housing and an internal shielding case, but not by any metal housing forming an external surface of the telephone.

Applicants submit that the cited references do not teach, or otherwise render foreseeable, a metal housing forming an external surface of the telephone and covering the front surface of the printed circuit board.

Moreover, claim 1 requires that the metal housing covers the front surface of the printed circuit board while leaving at least the part of the printed circuit board on which the internal antenna is disposed uncovered by the metal housing. In the hypothetical combination of Yokoyama's telephone and Crowley's docking arrangement, the internal antenna in Yokoyama's telephone would be located within Crowley's metal housing 16. Therefore, the internal antenna and the part of the circuit board on which the internal antenna is disposed would be covered by Crowley's metal housing 16. Accordingly, applicants submit that the cited references do not teach, or otherwise render foreseeable, a portable telephone housing configured by metal housing forming an external surface of the telephone that covers the front surface of a printed circuit board while leaving at least the part of the printed circuit board on which an internal antenna is disposed uncovered by the metal housing.

Applicants note that Crowley's docking system is part of an antenna transmission coupling arrangement for use with portable telephones having an external antenna (see Fig. 1). Crowley's coupling system shields the external antenna (3:7-14), permitting shielded use of the cellular telephone. Yokoyama's telephone has only an internal antenna and, therefore, is incompatible with Crowley's antenna transmission coupling arrangement. Accordingly, one of ordinary skill in the art would not place Yokoyama's telephone into Crowley's docking arrangement and would not combine these references as suggested in the Office action. Accordingly, applicants submit that the Examiner has not established a *prima facie* case for obviousness with respect to claim 1.

Further, the Examiner's reasons for why the invention would have been obvious (to make the phone structurally tough and strong at pages 3 and 4 of the Office action) are not found in the cited references, but in the present application. Yokoyama, for example, discusses the shielding case within the resin housing as prior art. In order to reduce the size and weight of the portable telephone, Yokoyama employs an electrically conductive film in its invention (1:35-41, 4:1-5). Therefore, Yokoyama teaches to use less metal in the telephone, not more, and effectively teaches away from the claimed invention. Neither reference teaches to make a portable telephone structurally tougher or stronger by employing a metal external housing and a resin housing. Accordingly, applicants submit that the Examiner has not established a *prima facie* case for obviousness with respect to claim 1.

In view of the above remarks, applicants respectfully submit that claim 1 is allowable over Yokoyama in view of Crowley. Claims 2-4, 9 and 10 depend from claim 1. The arguments provided above with respect to claim 1 also apply to claims 5-8 and 11.

Claims 10 and 11 were objected to for being dependent upon a rejected base claim, but include allowable subject matter.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No.: NGB-32439.

Respectfully submitted,
PEARNE & GORDON LLP

By: 
Brad C. Spencer, Reg. No. 57076

1801 East 9th Street
Suite 1200
Cleveland, Ohio 44114-3108
(216) 579-1700

Date: July 1, 2010